

**REMARKS**

Claims 1-3, 5-15, 17-24, 27-39, 41-53, 56-64, 67-74, 76, and 78-84 are pending in the present application. In this response, the applicant has amended claims 1, 2, 10, 11, 12, 24, 39, 43, 51, 53, 63, 64, and 74, as discussed in the examiner interviews of July 9 and 15, 2010. The above amendments to the claims and the following remarks are believed to be fully responsive to the outstanding office action and render all claims at issue patentably distinct over the cited references. The applicants respectfully request reconsideration and withdrawal of the rejections in view of the amendments and remarks contained herein.

**35 U.S.C. §103(a) Rejections**

Claims 1-3, 5-15, 17-24, 27-39, 41-53, 56-64, 67-74, 76, and 78-84 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the U.S. Patent No. 5,717,843 to Tabata (the "Tabata reference") in view of U.S. Patent Pub. No. 2003/0197896 to Kremer *et al.* (the "Kremer reference").

These rejections are traversed and the applicant submits that claims 1-3, 5-15, 17-24, 27-39, 41-53, 56-64, 67-74, 76, and 78-84 are distinguishable over the cited references, individually or in combination. However, in an attempt to expedite prosecution, the applicant has amended claims 1, 2, 10, 11, 12, 24, 39, 43, 51, 53, 63, 64, and 74 which are within the scope of the originally filed claims and are fully supported by the specification as originally filed. The applicants submit that the present amendments more clearly recite the limitations of the claims that are distinguishable over the cited references.

The Supreme Court decision in *KSR v. Teleflex*, held that any obviousness determination must be consistent with the traditional *Graham* factors. Thus, obviousness is determined according to (1) the scope and content of the prior art, (2) the level of ordinary skill in the art, (3) the differences between the prior art and the claimed invention, and (4) the extent of any objective indicia of nonobviousness.

A clear articulation of the reason why the claimed invention would have been obvious is required to support any rejection under 35 U.S.C. § 103. The analysis supporting a rejection under 35 U.S.C. § 103 should be made explicit. MPEP § 2143. Rejections for obviousness cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. MPEP § 2142.

In addition, the examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. In the case of independent claims 1, 12, 24, 39, 51, 63, and 74, the office action asserts that the Tabata and Kremer references teach all of the limitations claimed. To reject a claim based on this rationale, the office action must resolve the *Graham* factual inquiries. Then, the office action must articulate the following:

- (1) a finding that the prior art included each element claimed, although not necessarily in a single prior art reference, with the only difference between the claimed invention and the prior art being the lack of actual combination of the elements in a single prior art reference;
- (2) a finding that one of ordinary skill in the art could have combined the elements as claimed by known methods, and that in combination, each element merely performs the same function as it does separately;
- (3) a finding that one of ordinary skill in the art would have recognized that the results of the combination were predictable; and
- (4) whatever additional findings based on the *Graham* factual inquiries may be necessary, in view of the facts of the case under consideration, to explain a conclusion of obviousness. MPEP 2143(A).

The rationale to support a conclusion that the claim would have been obvious is that all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination yielded nothing more than predictable results to one of ordinary skill in the art. *KSR v. Teleflex*, 550 U.S. 398, 415-16 (2007); *Sakraida v. AG Pro, Inc.*, 425 U.S. 273, 282 (1976); *Anderson's-Black Rock, Inc. v. Pavement Salvage Co.*, 396 U.S. 57, 62-63 (1969); *Great Atlantic & P. Tea Co. v. Supermarket*

*Equipment Corp.*, 340 U.S. 147, 152 (1950). “[I]t can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does.” *KSR*, 550 U.S. at 418. If any of these findings cannot be made, then this rationale cannot be used to support a conclusion that the claim would have been obvious to one of ordinary skill in the art. MPEP § 2143(A). In the present case, the office action fails to fulfill several of these criteria with respect to the various claims. Therefore, the applicants respectfully traverse each of the rejections of the claims under 35 U.S.C. § 103(a), and because the rejections cannot be sustained, the applicants submit that the rejections should be withdrawn.

The cited references fail to disclose the claimed elements and limitations

The prior art reference when modified still must teach or suggest all the limitations of the rejected claim. The 35 U.S.C. § 103 obviousness rejections of these claims are thus inappropriate because one does not arrive at the present invention as recited in the claims by modifying the Tabata reference with any of the additionally cited references.

The Tabata and Kremer references

The applicants respectfully submit that the Tabata and Kremer references fail to disclose each and every limitation of the claims. For example, independent claim 1, as amended, requires:

[A]n interface linked to the multi-function device and the control system, wherein the interface is configured to allow the user during the generation of the electronic images for the multiple groups of documents to sequentially: enter a beginning sequence location for the binding element of a first group of documents prior to the generation of the electronic images for the first group of documents; enter an ending sequence location for the binding element of the first group of documents after the electronic images for the first group of documents have been generated; enter a beginning sequence location for the binding element of a second group of documents prior to the generation of the electronic images for the second group of documents; and enter an ending sequence location for the binding element of the second group of documents after the electronic images for the second group of documents have been generated.

Although the Tabata reference discloses temporarily saving a location of a staple or a hole punch prior to the scanning of documents, it merely discloses performing such an operation on a single group of documents at run time. Similarly, the Kremer reference discloses a system that allows a user to associate a selection of page features to a set of selected pages within a document. However, this may only be done after the pages have been scanned and saved into a document library and not concurrently as the electronic images are generated. The Kremer reference specifically states that it is only after the “documents are loaded into the workflow management software” that the system is able to “perform value added services and prepare the documents for production.” (See ¶ [0042] of the Kremer reference). Therefore, the applicants respectfully submit that the cited reference do not disclose, teach, or suggest capturing organizational or binding information for multiple groups of documents at the time the electronic images are generated.

Independent claims 12, 24, 39, 51, 63, and 74 have also been amended to more distinctly recite the limitations pertaining to how binding information is captured. Each of these amendments is fully supported by both the claims as originally filed and by the applicants’ specification at paragraphs [0042]-[0052]. The applicants respectfully submit that since neither the Tabata nor Kremer reference discloses capturing information relating to the sequence location of a binding element for multiple groups of documents within a larger collection of documents concurrently when the documents are scanned, the cited references cannot support a *prima facie* case of obviousness, and the rejections of the claims should be withdrawn.

The Tabata, Kremer, and Nakakiri references

The office action asserts that the Tabata and Kremer references disclose each of the limitations of claims 10, 11, 22, 23, 37, 38, 49, 50, 61, 62, 72, 73, 83, and 84 except for storing a viewer program on the medium. The office action then states that the Nakagiri reference discloses such a limitation, and when viewed in combination with the Tabata and Kremer references, it would have been obvious to one of ordinary skill in the

art to include the feature of storing a viewer program on a medium. The applicants respectfully traverse these rejections.

The Nakagiri reference teaches only that program code containing printing information is stored on a computer readable medium. The medium may then be used by the host computer to preview images. However, the Nakagiri reference fails to teach that a program for viewing the images is also stored on the medium along with the printing information. The system of the Nakagiri reference still requires a host computer to read the data on the medium. Conversely, claims 10, 11, 22, 23, 37, 38, 49, 50, 61, 62, 72, 73, 83, and 84 require that a "viewer program" be stored on the medium. Therefore, since the limitation of storing "a viewer program on the medium" as recited in claims 10, 11, 22, 23, 37, 38, 49, 50, 61, 62, 72, 73, 83, and 84 is not found in any of the cited references, the rejections of the claims cannot be supported and should be withdrawn.

Inasmuch as claims 2, 3, 5-11, 13-15, 17-23, 27-38, 41-50, 52, 53, 56-62, 64, 67-73, 76, and 78-84 depend from and include all the limitations of independent claims 1, 12, 24, 39, 51, 63, and 74, as amended, the applicant's respectfully request that the rejections of claims 2, 3, 5-11, 13-15, 17-23, 27-38, 41-50, 52, 53, 56-62, 64, 67-73, 76, and 78-84 also be withdrawn.

The office action fails to provide a showing that one of ordinary skill in the art would have recognized that the results of the combination were predictable

To support a finding of obviousness, the cited references must expressly or impliedly suggest the claimed invention or the examiner must provide a convincing line of reasoning as to why the claimed invention would have been obvious to one skilled in the art. Reliance upon the knowledge of the person of ordinary skill in the art is not sufficient without that knowledge being instantly and unquestionably demonstrable as being well-known. MPEP § 2144.03(A). Reliance on such "common knowledge" without greater support is specifically prohibited:

A statement that modifications of the prior art to meet the claimed invention would have been "well within the ordinary skill of the art at the time the claimed invention was made" because the references relied upon teach that all aspects of the claimed invention were individually known in

the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references.

*Ex Parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App & Inter. 1993). “There must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *KSR v. Teleflex*, 550 U.S. 398, 418 (2007). Further, “a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art.” *Id.* It is important for the office action “to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does.” *Id.*

The office action contends that one skilled in the art would be motivated to combine the Tabata reference with the teachings of the Kremer reference for the purpose of storing a sequence location of a binding element. However, none of the references explicitly or implicitly suggest storing a sequence location for a binding element for multiple groups of documents within a collection of documents concurrently with the generation of electronic images. Therefore, the office action must provide a valid line of reasoning why one of ordinary skill in the art would be motivated to combine the references as suggested in the office action for the purpose of predictably arriving at the present claims.

The applicants submit that the Kremer reference specifically requires that the documents comprising the selected pages be “loaded into the workflow management software” before they can be prepared for production. This inherently requires that the documents have already been scanned and saved in some manner such that they may then be loaded into a software program. (See ¶¶ [0042] and [0045] of the Kremer reference). The Kremer reference explicitly states that “job preparation 106 may include scanning the documents and creating a faithful and error free electronic reproduction. The documents, once in electronic form, must also be distilled down or converted into a common file format that the print shop can use to both edit and print the documents.” (See ¶ [0026] of the Kremer reference). The applicants respectfully submit that one of ordinary skill in the art would not be motivated by the teachings of the Kremer reference

to modify the Tabata reference as suggested in the office action when the Kremer reference requires that the scanned documents be saved and converted into a different format prior to being able to edit the scanned documents. Additionally, the Tabata reference is directed towards a system that uses a stored staple or hole punch location to calculate the amount of image shift required on each printed page to keep each image viewable to a reader based on the number of pages in a particular batch of scanned documents.

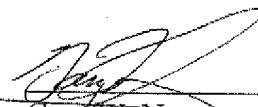
Therefore, the applicants submit that because a *prima facie* case of obviousness has not been established, the rejections of the claims cannot be supported. Accordingly, the applicants respectfully request that the rejections of the claims be withdrawn.

### CONCLUSION

Please consider the amendments and remarks. In view of the present amendments and comments, the applicants respectfully submit that the claims are in condition for allowance. Please contact the undersigned attorney at the address and telephone number noted below with any questions or comments.

Respectfully submitted,

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